

Vinson & Elkins
ATTORNEYS AT LAW

VINSON & ELKINS L.L.P.
THE TERRACE 7
2801 VIA FORTUNA, SUITE 100
AUSTIN, TEXAS 78746
TELEPHONE (512) 542-8400
FAX (512) 542-8612
www.velaw.com

David P. Blanke
Direct Dial (512) 542-8622
Direct Fax (512) 236-3314
dblank@velaw.com

February 17, 2003

By Overnight Delivery

Michael N. Milby
United States District Court
Southern District of Texas
515 Rusk Avenue
Houston, Texas 77002

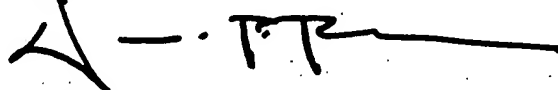
Re: *Clontech Laboratories, Inc. v. Baylor College of Medicine, et al.*;
United States District Court for the Southern District of Texas, Houston Division;
Civil Action No. 4-02-0017

Dear Mr. Milby:

Enclosed for filing with the papers of the above referenced case are an original and one copy of Baylor's second motion to dismiss with accompanying covenant not to assert. Also enclosed is an extra copy, which we ask that you file mark and return in the enclosed self-addressed, stamped envelope.

Thank you for your assistance in this regard.

Very truly yours,



David P. Blanke

c: Glenn A. Ballard, Jr.
Richard J. Oparil
Kevin Bell
(all w/encls.; by fax and first class mail)

IN THE UNITED STATES DISTRICT COURT
FOR THE SOUTHERN DISTRICT OF TEXAS
HOUSTON DIVISION

CLONTECH LABORATORIES, INC.,

Plaintiff,

v.

BAYLOR COLLEGE OF MEDICINE and
BMC TECHNOLOGIES, INC.,

Defendants.

§
§
§
§
§
§
§
§
§
§

Civil Action No. H02-0017

**BAYLOR'S SECOND MOTION TO DISMISS
WITH ACCOMPANYING COVENANT NOT TO ASSERT**

Defendants BCM Technologies, Inc. and Baylor College of Medicine (collectively, "*Baylor*") file this second motion to dismiss, with an accompanying covenant not to assert the disputed patent, respectfully submitting that this case should be dismissed for want of subject matter jurisdiction.

I.

This declaratory judgment action seeks to invalidate United States Patent No. 5,851,808 (the "*Disputed Patent*"), which was issued to Drs. Stephen J. Elledge and Qinghua Liu on December 22, 1998, and assigned to Baylor. Last year, Baylor moved to dismiss this case, arguing that there is no case or controversy regarding the Disputed Patent between Baylor and Clontech Laboratories, Inc. ("*Clontech*"). Recently, the Court denied that motion. "Based on the totality of the circumstances," the Court concluded that "an actual case of controversy exists with respect to the [Disputed Patent]." Memorandum & Order, entered February 6, 2003, at pp. 12-13.

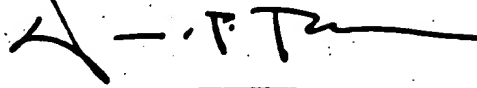
II.

As Clontech recognized in its papers opposing Baylor's motion, "Baylor itself can control the disposition of this action." Plaintiffs Opposition to Defendants' Motion to Dismiss, filed March 25, 2002, at p. 14. "[A] patentee defending an action for declaratory judgment of invalidity can divest the trial court of jurisdiction over the case by filing a covenant not to assert the patent at issue against the putative infringer with respect to any of its past, present, or future acts." *Id.* (quoting *Super Sack Mfg. Corp. v. Chase Packaging Corp.*, 57 F.3d 1054, 1058 (Fed. Cir. 1995), *cert. denied*, 516 U.S. 1093 (1996)). Baylor's initial motion to dismiss did not include such a covenant.

III.

With this second motion to dismiss, Baylor submits a covenant not to assert the Disputed Patent. See Exhibit A. That covenant "divest[s] the trial court of jurisdiction over the case." *Super Sack Mfg. Corp.*, 57 F.3d at 1058. For that reason, Baylor respectfully submits the Court should dismiss this case for want to subject matter jurisdiction.

Respectfully submitted,



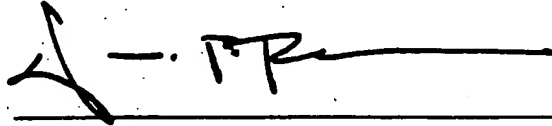
David P. Blanke
Attorney-in-Charge
State Bar No. 02453600
Tracey B. Davies
State Bar No. 24001858
M. Michelle Muller
State Bar No. 24037155
VINSON & ELKINS L.L.P.
The Terrace 7
2801 Via Fortuna, Suite 100
Austin, Texas 78746-7568
Tel: (512) 542-8400
Fax: (512) 542-8612

Jason M. Powers
State Bar No. 24007867
David Wooten
State Bar No. 24033477
VINSON & ELKINS L.L.P.
1001 Fannin Street
Suite 2300
Houston, Texas 77002-6760
(713) 758-2222
(713) 758-2346 (Fax)

*Attorneys for Defendants Baylor College of
Medicine and BCM Technologies, Inc.*

CERTIFICATE OF SERVICE

I certify that on February 17, 2003, a true and correct copy of the foregoing was served on (i) Glenn A. Ballard, Jr. of Bracewell & Patterson LLP, 711 Louisiana St., Suite 2900, Houston, TX 77002-2781 (*by fax and first class mail*); (ii) Richard J. Oparil of Patton Boggs LLP, 2550 M Street, NW, Washington, DC 20037 (*by fax and first class mail*) and (iii) Marc R. Labgold and Kevin M. Bell of Patton Boggs LLP, 8484 Westpark Drive, Suite 900, McLean, VA 22102 (*by fax and first class mail*).

A handwritten signature in black ink, appearing to read "D. P. Blanke", is written over a horizontal line.

David P. Blanke